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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,288	06/20/2003	Alan K. Schaer	09610.1271	1511

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Edward J Lynch
One Market Plaza
Spear Street Tower Suite 2100
San Francisco, CA 94105

EXAMINER

COHEN, LEE S

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,288

Applicant(s)

SCHAER, ALAN K.

Examiner

Lee S. Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Reissue Applications

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. The declaration statement only related to the specification and not the claims.

Claims 1-77 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Double Patenting

Claim 77 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 36. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 56-58, 69 and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 56-58 reference a jacket, which element has not been previously recited. Method claim 69 improperly depends upon apparatus claim 53. Regarding claim 77, the word "means" is preceded by the word(s) "electrode" in an attempt to use a

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"means" clause to recite a claim element as a means for performing a specified function.

However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Khumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36, 37, 46-48, 51, 59, 60, 71, 72, and 77 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Panescu et al (5,769,847). Applicant's attention is directed to columns 5-8 and, in particular, the figure 9 embodiment. Panescu et al also disclose at column 6, lines 28-32, that the electrodes can be as small as 4 French (1.35 mm) in diameter and have lengths varying from about 2 mm to about 10 mm. Adjacent electrodes are spaced no farther apart than about 2.5 times an electrode diameter. Accordingly, the electrode spacing can be within the claimed range. The reference further discloses a core member 28 that extends into a jacket (see Figure 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al (5,769,847). The recited methods are deemed to be obvious over the Panescu et al reference. Detecting electrical activity with the electrodes after delivering ablation energy is conventional in the art and would have been an obvious step. Further, the Panescu et al method encompasses delivering of energy to the electrodes in various patterns (i.e., sequential) to achieve optimum lesion formation.

Claims 38, 40-45, 50, 52, 61-67, 70, and 73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al (5,769,847) in view of Littman et al (5,509,411). Littman et al disclose the use of braided helical conductors in a shaft that partially covers the electrodes as well as the particular core structure to have been well known in the art. The reference also discloses the use of a distal tip coil member. Given these teachings, it would have been obvious to the skilled artisan to incorporate these features in the Panescu et al device to render it more flexible and maneuverable.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al (5,769,847) in view of Littman et al (5,509,411) as applied to claim 38, and further in view of Alferness et al (5,531,781). The distal tip coil member of Littman et al fails to include a polymeric cover. Alferness et al disclose a similar coil tip with such a cover (column 5, lines 5-7). Given this teaching, it would have been obvious to the skilled artisan to incorporate such a cover to render the device safer for intravascular use.

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Claims 30 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al (5,769,847) in view of Nashef et al (5,509,411). Nashef et al disclose the use of a metal band about a temperature sensor to improve its performance. Applicant's attention is directed to Figure 1, elements 19 and 20. The reference further discloses the use of a jacket as detailed at column 13, lines 46-48. The jacket comprises the heat means coil and the insulator. As claimed, an insulating jacket is not disposed directly on the metal band. Given this teaching, it would have been obvious to the skilled artisan to incorporate such features in Panescu et al to effect superior temperature sensing. Further, the process by which the band is attached to the temperature sensor is within the level of skill for the artisan to select to optimize performance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lee S. Cohen
Primary Examiner
Art Unit 3739

LSC
June 2, 2005